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09/121,725	07/24/1998	ERNEST A. VOISIN	V98-1054	3626

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EXAMINER	
BECKER, DREW E	

ART UNIT	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/121,725
Filing Date: July 24, 1998
Appellant(s): VOISIN, ERNEST A.

Thomas S. Keaty
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 30, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the first issue is the rejection of claims 6 and 27 under 35 U.S.C. 102(b) including inherency, and the second issue is the rejection of claims 3-4 and 7 under 35 U.S.C 103(a).

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant does not argue the claims separately and

distinctly. Appellant argues claims 6 and 27 as a group, and does not supply further arguments regarding claims 3-4 and 27.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

JP 4356156A	Yasushi et al	12-1992
5,773,064	Tesvich et al	6-1998

Jean-Claude Cheftel, "Effects of high hydrostatic pressure on food constituents: an overview", High Pressure and Biotechnology, Vol. 224, 1992.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 4356156A.

JP 4356156A teach a method of treating shellfish comprising exposing raw oysters (paragraph 0005) contained in plastic bags filled with sea-water (paragraph 0010) to

hydrostatic pressures of 14,223-56,892 psi for 0.5-10 minutes at ambient temperatures without heating, thermal damage, or mechanical damage (paragraph 0006). Although JP 4356156A do not recite an effect upon pathogenic Vibriones bacteria, this would have inherently occurred. The method steps utilized in the reference are the same as those instantly claimed, and thus one of ordinary skill in the art would have expected the same results. The claimed characteristic of eliminating pathogenic Vibriones bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary. Further, it was known that high pressure treatment of seafood destroyed pathogenic organisms such Vibrio, as evidenced by Cheftel [Effects of high hydrostatic pressure on food constituents: an overview] (page 204, heading 1.2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 4356156A in view of Tesvich et al [Pat. No. 5,773,064].

JP 4356156A teaches the above mentioned concepts. JP 4356156A does not recite retaining the treated shellfish at below ambient temperature or the use of bands.

Tesvich et al teach a method of processing shellfish by banding them (Figure 1, #18) and then refrigerating the treated shellfish (column 2, lines 53-56). It would have been obvious to one of ordinary skill in the art to incorporate the refrigerated storage of Tesvich et al into the invention of JP 4356156A since both are directed to methods of processing shellfish, since the pressure treated shellfish of JP 4356156A were raw and uncooked, and since storing raw and uncooked foods at refrigeration temperatures was a common method of food preservation, as shown by Tesvich et al. It would have been obvious to one of ordinary skill in the art to incorporate the bands of Tesvich et al into the invention of JP 4356156A since both are directed to methods of treating shellfish, since JP 4356156A already included placing the shellfish into plastic bags filled with seawater (paragraph 0010) as well as the opening of the shellfish during pressurization (paragraph 0009), and since the bands of Tesvich et al kept the shells from opening during processing, provided advertising logos and other indicia which would better promote the product to the consumer, and also provided evidence of tampering (column 6, lines 36-64).

(11) Response to Argument

It should first be noted that this application has been to appeal once already regarding the subject of inherency. Attention is drawn to the Board of Patent Appeals and Interferences decision of March 10, 2003 in which the rejection was upheld.

Appellant argues that JP 4356156A does not disclose the use of 20,000 psi or at pressures greater then 56,892 psi. However, JP 4356156A clearly teaches the use of

pressure in the range of 1,000-4,000 ATM, or 14,223-58,692 psi, (paragraph 0006). Regarding pressures greater than 56,892 psi, this point is irrelevant since the appellant's claimed range is 20,000-80,000 psi, and JP 4356156A clearly falls within this range. In addition, appellant fails to provide any proof or evidence that the use pressure above 56,892 psi would have any different or improved effects.

Appellant argues against the inherent microbiological effects of the method of JP 4356156A. Although JP 4356156A does not recite any effect upon pathogenic Vibriones bacteria, the method steps utilized in the reference are the same as those instantly claimed, and thus the same results would also have been expected. The claimed characteristic of eliminating pathogenic Vibriones bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary on the record. Further, it was known that high pressure treatment of seafood destroyed pathogenic microorganisms such as Vibrio, as evidenced by Cheftel (page 204, heading 1.2). Regarding inherency, paragraph 2112 of the MPEP states: "The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims and MPEP § 2141.02 with regard to inherency and rejections under 35 U.S.C. 103."

Appellant appears to direct their main arguments against the Cheftel reference. However, the Cheftel reference was merely used as an evidentiary reference to show

that high pressure preservation of seafood, via destruction of bacteria such as Vibrio, was commonly known. It does not add to the teachings of JP 4356156A, such as in a 103 rejection, but rather merely provides evidence of the teaching of the JP 4356156A patent. Attention is drawn to paragraph 2131.01 which states: "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) "

Appellant argues that disclosure of JP 4356156A is not enabled by citing the declarations Ernest Voisin which are attached to the Brief. However, the first declaration was never cited in this application and was actually entered in a different application. Regardless, both declarations are directed to the subject of shucking, rather than the claimed effect of pasteurization via elimination of bacteria and therefore are not relevant to the instant claims. Furthermore, the tests and comparisons listed in the declarations rely upon specific water temperatures and JP 4356156A did not recite, or rely upon, any of these temperatures during its process. Therefore appellant's tests were not conducted with identical conditions and method steps taught by JP 4356156A. Appellant also cites JP 2000157157A. However, this reference was not used in the final rejection and therefore is not relevant. Also, appellant equates 50°F with "ambient temperature". However, there is no evidence of this in JP 4356156A.

Regarding the issue of a non-enabling disclosure, appellant seems to ignore the fact that JP 4356156A teaches and successfully uses the exact same process steps as those which are currently claimed (paragraphs 0008 & 0013). Furthermore, it is not understood how the appellant would be successful, but the JP reference would be unsuccessful, while using the exact same process steps and materials.

Appellant refers to Exhibits 5-8, however these were not included with the brief. These declarations were filed with the response of October 9, 2003 and can be found there. The apparent "conclusions" cited by appellant appear to either ignore, or misinterpret, the concept of inherency. Although JP 4356156A does not recite any effect upon pathogenic Vibriones bacteria, the method steps utilized in the reference are the same as those instantly claimed, and thus the same results would also have been expected. The claimed characteristic of eliminating pathogenic Vibriones bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary on the record. Further, it was known that high pressure treatment of seafood destroyed pathogenic microorganisms such as Vibrio, as evidenced by Cheftel (page 204, heading 1.2). Regarding inherency, paragraph 2112 of the MPEP states: "The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). This conclusion was also affirmed by the Board of Patent Appeals and Interferences in its decision of March 10, 2003.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In conclusion, the rejection should be affirmed for the reasons stated above, namely that JP 4356156A teaches and successfully uses the exact same process steps as those which are currently claimed (paragraphs 0008 & 0013), and for the reasons stated in the decision of the Board of Patent Appeals and Interferences of March 10, 2003 since the claims are essentially the same.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner
Art Unit 1761

DREW BECKER
PRIMARY EXAMINER
10-13-04

October 7, 2004

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